

REMARKS

In the April 17, 2009 Office Action, all of the claims stand rejected in view of prior art. No other objections or rejections were made in the Office Action.

Status of Claims and Amendments

In response to the April 17, 2009 Office Action, Applicant has amended claim 1, as indicated above. Specifically, claim 1 has been amended to re-word the negative limitation to conform to MPEP 2173.05(i). More specifically, the negative limitation language “other than” has been changed to “free from”, as was considered definite. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970). Thus, claims 1, and 3-9 are pending, with claim 1 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

The amendments to claim 1 are supported on page 7, lines 15-21 of the specification as originally filed.

Entry of October 31, 2008 Amendment

In paragraph 1 of the Office Action, the Office Action indicated that Applicant's March 10, 2009 RCE and accompanying Submission which included amendments to claim 1, has been entered.

In paragraph 2 of the Office Action, the Office Action acknowledged the claim amendments and confirmed that no new matter had been introduced.

Rejections - 35 U.S.C. § 103

In paragraph 5 of the Office Action, claims 1 and 3-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,245,182 (Nakamura) in view of U.S. Patent No. 4,837,274 (Kawakubo et al.).

In response, Applicant has amended independent claim 1 to re-word the negative limitation to conform to MPEP 2173.05(i). More specifically, the negative limitation language “other than” has been changed to “free from”. The court has affirmed that the language “free from” is considered definite when used to recite a ***negative limitation***. *In re Wakefield*, 422 F.2d 897, 899, 904, 164 USPQ 636, 638, 641 (CCPA 1970).

Applicant respectfully asserts that the rejection is improper because the Office Action has mis-interpreted the limitations of claim 1 and mis-applied the cited prior art. Specifically, claim 1 requires that the heat-curing agent of the thermosetting and active energy ray curable resin composition be ***free from compounds containing one or more isocyanate groups***. The Office Action has rejected claim 1 based upon that prior art that ***requires*** compounds containing one or more isocyanate groups.

Independent claim 1 clearly recites that a thermosetting and active energy ray curable resin composition requires a heat-curing agent that is ***free from compounds containing one or more isocyanate groups***. This arrangement is ***not*** disclosed or suggested by the Nakamura patent, the Kawakubo et al. patent or any other prior art of record. Further, as discussed below, both the Nakamura patent and the Kawakubo et al. patent ***teach away*** from the claimed invention and from one another.

On page 3, lines 13-15 of the Office Action, the Office Action acknowledges that

Nakamura teaches the ***inclusion*** of a polyfunctional isocyanate (heat curing agent) for purposes of providing tack to the material prior to curing . . . (*emphasis added*)

The claimed invention, on the other hand, is *free from* compounds containing one or more isocyanate groups.

Therefore, the rejection is improper and must be withdrawn.

The Kawakubo et al. patent also discloses a curing agent that includes an isocyanate group. Specifically, at column 5 lines 5-13 and at column 10, lines 26-33 of the Kawakubo et al. patent polyisocyanate compounds and isocyanate groups are explicitly described.

Since both the Nakamura patent and the Kawakubo et al. patent specifically teach the use of isocyanate and/or polyfunctional isocyanate, a person of ordinary skill in the art would have no reason to combine the Nakamura patent and the Kawakubo et al. patent to achieve a thermosetting and active energy ray curable resin composition with a curing agent that must be *free from compounds containing one or more isocyanate groups*.

Therefore, the rejection is improper and must be withdrawn.

As well, a person of ordinary skill in the art would have no reason to combine the Nakamura patent with the Kawakubo et al. patent because the Nakamura patent and the Kawakubo et al. patent teach away from one another. Specifically, the Nakamura patent teaches the use of a polyfunctional isocyanate "for keeping stickiness of the protecting printed layer 2 prior to irradiation with an active energy ray low" (see column 8 at lines 1-11 of the Nakamura patent). In other words, the Nakamura patent seeks to reduce adhesion with the inclusion of an isocyanate. The Kawakubo et al. patent, on the other hand, discloses the inclusion of a silane coupling agent or an aromatic poly-isocyanates added to a base polymer as *adhesion accelerators* (column 10 at lines 27-33). That is, the Nakamura patent and the Kawakubo et al. patent use isocyanate in order to achieve different and opposite results. Therefore, a person of ordinary skill in the art would have no reason to combine the adhesion

accelerating properties taught by the Kawakubo et al. patent with the adhesion reducing properties taught by the Nakamura patent.

Under U.S. patent law, the mere fact that the prior art can be modified does **not** make the modification obvious, unless an **apparent reason** exists based on evidence in the record or scientific reasoning for one of ordinary skill in the art to make the modification. See, KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). The KSR Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed." Id. at 1741. The current record lacks any apparent reason, suggestion or expectation of success for combining the patents to create Applicants' unique arrangement of a resin compound.

Moreover, Applicant believe that dependent claims 3-9 are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Also, the dependent claims 3-9 are further allowable because they include additional limitations. Thus, Applicant believe that since the prior art of record does not disclose or suggest the invention as set forth in independent claim 1, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

Therefore, Applicant respectfully request that this rejection be withdrawn in view of the above comments and amendments.

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Appl. No. 10/533,137
Amendment dated July 9, 2009
Reply to Office Action of April 17, 2009

In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1 and 3-9 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

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